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10/627,919

07/28/2003

Paul L. Baker

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EXAMINER

OBEID, MAMON A

ART UNIT

PAPER NUMBER

3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/627,919

Applicant(s)

BAKER, PAUL L.

Examiner

Mamon Obeid

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. This is in reply to application filed on 28 July 2003.
2. Claims 1-5 have been cancelled
3. Claims 6-24 have been added.
4. Claims 6-24 are currently pending and have been examined.

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 16-24 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well-established utility.
7. Claim 16 recites the limitation "*the broker comparing the encrypted positions and notifying each party about the extent of a potential agreement, wherein the one-way encryption prevents the broker from decoding the content of the negotiating positions*", it is unclear to the examiner how the broker is able to compare the negotiation positions without decrypting/decoding the content of the negotiation positions.

8. Claims 16-24 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.
9. "A claimed invention having an inoperable or impossible claim limitation may lack utility under 35 U.S.C. §101 and certainly lacks an enabling disclosure under 35 U.S.C. §112." *EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423, 1427 (Fed. Cir. 2001) (citations omitted).

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
11. Claims 6-15 and 16-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. The term "*in a way*" in claim 1 is a relative term which renders the claim indefinite. The term "*in a way*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

invention. The applicant is required to reveal the specific way that conceals the negotiation positions.

13. The term "*one-way encryption key*" in claim 1 is a relative term which renders the claim indefinite. The term "*one-way encryption key*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examination purposes, the examiner will interpret the term "*one-way encryption key*" as a general encryption key.
14. Claim 1 recites the limitation "*wherein, upon receiving both partially encrypted negotiation positions, the broker compares them to discover whether there exists an encrypted statement that is compatible with both negotiating positions*". The examiner is unclear on what the term "*compatible*" is referring to. It's also unclear to the examiner what the criteria that determines compatibility is. Appropriate clarification is required.
15. The term "*apparent*" in claim 1 is a relative term, which renders the claim indefinite. The term "*apparent*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

invention. For examination purposes, the examiner will interpret the limitation "*apparent basis-for-agreement*" as merely a basis-for-agreement.

16. Claim 1 recites the limitation "*the encrypted basis-for-agreement*". There is insufficient antecedent basis for this limitation in the claim.
17. Claim 16 recites the limitation "*acceptable negotiation partners*", which renders the claim vague and indefinite. It's unclear to the examiner what the criteria that determines the "acceptable negotiation partner" and the unacceptable negotiation partner. Appropriate clarification is required.
18. Claim 16 recites the limitation "*the extent of a potential agreement*" which renders the claim vague and indefinite. It's unclear to the examiner what the term "*extent*" is referring to. Appropriate clarification is required.
19. Claims 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.
20. Claim 1 recites the limitation "*wherein the party who is asked to begin negotiation sends a one-way encryption key to the other party by a public key encryption system, said broker not possessing the one-way encryption key*". The claim omits

the step of asking the party to initiate the negotiation, before said party sends an encryption key to the other party.

21. Claim 1 recites the limitation "*wherein each party applies the one-way encryption key to partially encrypt to their negotiating positions*". The examiner is unclear on how the partial encryption is performed and what's encrypted and what's not encrypted. The essential step that clarifies the partial encryption is required to get a better understanding of what the applicant is claiming.
22. Claim 14 recites the limitation "*concealing numerical values and value ranges in a negotiating position by linear mapping of values using a secret offset and secret scaling factor*". The examiner is unclear on what those numerical values and value ranges come from. Applicant is required to disclose the step that results in numerical values and value ranges and the step that defines/ introduces the secret offset and the secret scaling factor.
23. Claim 15 recites the limitation "*using the one-way encryption key, encrypting the name of a value set as a number with  $2n$  bits, separating high order bits from low order bits, and converting the two numbers of  $n$  bits to an offset and scaling factor which are then applied to values in the value set*". The examiner is unclear on what the "value set", the variable " $n$ " and the "the two numbers" are. Applicant is required to disclose the step that results in value set and the step that defines the two numbers and the step that defines what  $n$  really is.

***Claim Rejections - 35 USC § 102***

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

25. Claims 6, 8-17, 19 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al., U.S. Patent No. 5,794,207.
26. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
27. **As per claim 6, 16 and 21:** Walker discloses the following limitations:
- *conducting a negotiation between two parties through a broker in a way that conceals negotiating positions of the two parties (see at least column 8, lines 41-55);*



- *wherein each party receives from the broker a dictionary of words for description of the negotiating positions, and a schema for descriptive statements in the negotiating positions (see at least column 16, lines 63-67 and column 17, lines 1- 7);*
- *wherein the party who is asked to begin negotiation sends a one-way encryption key to the other party by a public key encryption system, said broker not possessing the one-way encryption key (see at least column 13, lines 1-10) ;*
- *wherein each party applies the one-way encryption key to partially encrypt to their negotiating positions (see at least column 13, lines 54-59);*
- *wherein each party sends its partially encrypted negotiating position to the broker via the public key encryption system (see at least Figures 5 &10 and related text) ;*
- *wherein, upon receiving both partially encrypted negotiation positions, the broker compares them to discover whether there exists an encrypted statement that is compatible with both negotiating positions (see at least column 19, lines 30-45);*
- *wherein the broker notifies each party about an apparent basis-for-agreement (see at least column 19, lines 30-45);*

- *wherein the broker provides the parties with a copy of the encrypted basis-for-agreement (see at least column 28, lines 1-15);*
  - *wherein each party decodes the basis-for-agreement (see at least column 13, lines 54-59).*
28. **As per claim 8 , 19 and 22:** Walker discloses *wherein both parties use the one-way encryption key to derive a codebook from the dictionary (see at least column 12, lines 21-33).*
29. **As per claim 9:** Walker discloses *wherein both parties never receive a full copy of the opposite party's negotiating position (see at least column 28, lines 1-15).*
30. **As per claim 10:** Walker discloses *wherein the broker allows a party to see a list of potential negotiation partners and the party has the opportunity to make a selection of acceptable negotiating partners (see at least column 23, lines 45-59).*
31. **As per claim 11:** Walker discloses *wherein each party may modify their negotiation position so that it is specific for each potential negotiating partner (see at least column 1, lines 26-35).*

32. **As per claim 12:** Walker discloses *wherein the broker retains an historical record of the negotiation* (see at least column 6, lines 35-44).
33. **As per claim 13:** Walker discloses *wherein the broker is unable to decrypt the negotiation positions or the basis-for-agreement* (see at least column 12, lines 21-44).
34. **As per claim 14:** Walker discloses *concealing numerical values and value ranges in a negotiating position by linear mapping of values using a secret offset and secret scaling factor* (see at least column 25, lines 35-54).
35. **As per claim 15:** Walker discloses *using the one-way encryption key, encrypting the name of a value set as a number with  $2n$  bits, separating high order bits from low order bits, and converting the two numbers of  $n$  bits to an offset and scaling factor which are then applied to values in the value set* (see at least column 25, lines 35-54).
36. **As per claim 17:** Walker discloses *developing the basis-for-agreement into a binding agreement by direct negotiation between the two parties* (see at least column 25, lines 35-54).

37. **As per claim 23:** Walker discloses *wherein data to be exchanged through the negotiation comprises intelligence data, price information, or intellectual property holdings* (see at least column 10, lines 40-56).
38. **As per claim 24:** Walker discloses *wherein the negotiating is online* (see at least column 15, lines 45-59).

***Claim Rejections - 35 USC § 103***

39. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
40. Claims 7, 18 and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Applicant's own Admission.
41. **As per claim 7, 18 and 20:** Walker discloses the limitations of claim1 as shown above. Walker does not disclose *wherein the schema uses XML, XML-DTD, or BNF Grammar*. However, applicant admits that XML is old and well known in the art (see application publication in at least paragraph [0018]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify walker's Assisted Commercial Network System to include XML to facilitate the sharing of structured data across different information systems, particularly via the Internet.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner: Mamon Obeid

Art Unit: 3621

Date: September 12, 2007

Signature: 



ANDREW J. FISCHER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Serial No, 10/627,919  
AMENDMENT  
Docket No. 907.0002

**AMENDMENTS TO THE DRAWINGS:**

The attached replacement sheet includes a change to FIG. 1 to show that Party B Modifies Position for Party A. Currently, the arrow is misplaced as it extends from the Broker and not Party B. See paragraph [0048] of the published application, U.S. Patent Application Publication 2007/0005962 A1. No new matter is added.

Attachment:

Replacement Sheet for FIG. 1

# REPLACEMENT SHEET

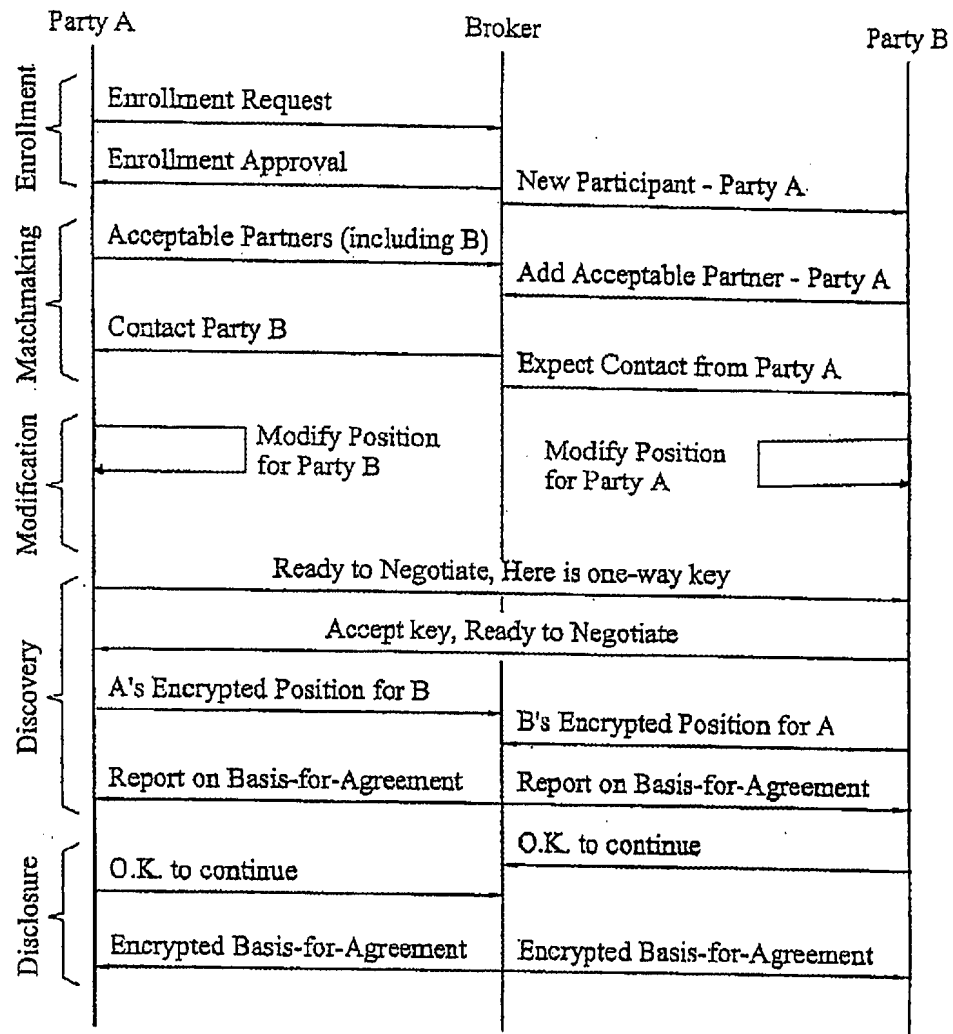


FIG. 1